

REMARKS/ARGUMENTS

This Amendment and Response is promptly filed to place the above-referenced case in condition for immediate allowance. No claims have been cancelled. No claims have been amended. Claims 17 and 18 have been added. Claims 1-18 are outstanding in the application.

No new matter has been added to the application. The list of all patents, publications, and other information submitted for consideration by the Office is enclosed for the Examiner's indication.

From the outstanding Office action: Claims 1-4 and 6-10 are rejected under 35 U.S.C § 103(a) as being unpatentable over the Masuda '738 patent in view of the Moronaga et al. '598 patent. Claim 5 is rejected under 35 U.S.C § 103(a) as being unpatentable over Masuda and Moronaga et al. and further in view of the Baermann '532 patent. Claims 11-14 are rejected under 35 U.S.C § 103(a) as being unpatentable over Masuda and Moronaga et al. and further in view of the Bloom '544 patent. Claims 15 and 16 are rejected under 35 U.S.C § 103(a) as being unpatentable over Masuda in view of Moronaga et al., Baermann, and Bloom.

Applicants have added new claims 17 and 18 which supplies subject matter that was previously present in the application and that is related to the issued parent application, US Patent No. 6,322,491.

Before proceeding into the arguments as to why the combination of references supplied by the Examiner is not applicable to Applicants' claims, Applicants briefly summarizes the cited patents, particularly Masuda and Moronaga et al.

In the Masuda '738 patent, it should be noted in Figure 5 that two sheets of flexible reinforcing material 8, 9 are laid within a rubber magnet plate 7 whose entire surfaces are

formed with a protective coating 10 with a polyurethane coating or the like. Masuda '738, column 2, lines 60-63.

This specific and limiting description in the Masuda '738 patent is importantly consistent with the goal of completely preventing cracks and tears caused in the insole by bending stress in order to improve the durability of the insole body. Masuda '738, column 2, lines 1-3. As the two sheets of reinforcing material are positioned along with surfaces of the insole body, the occurrence of cracks thereon can also be prevented and the physical strength is improved. Masuda '738, column 2, lines 3-6.

Consequently, it is a specific and important goal of the Masuda '738 patent to prevent cracks and tears in the insoles. This is reflected by the background section of the Masuda '738 patent where it is stated that, "since the rubber sheet 22 is not strong physically, when the bending stress or the like has occurred in use, considerable difficulty was encountered as regards durability such as becoming unusable by cracks and tears produced on the rubber sheet 22. Masuda '738, column 1, lines 23-28.

Furthermore, Masuda et al. discloses only and is directed uniquely towards having a "line of magnetic force applied to the entire sole of the foot." Masuda '738, column 1, lines 65-66; column 3 lines 60-62. No disclosure is made or indicated in the Masuda '738 patent for the variation or alternation of magnetic fields due to this design goal.

Due to the foregoing goals, directions, features, and characteristics of the Masuda '738 patent, it can be seen that the problem solved with respect to the Masuda '738 patent is one of having a magnetic insole that is less subject to cracks and tears while having a single pole on each side of the insole. No other indication of optional embodiments and the like are set forth in the Masuda '738 patent. As set forth in more detail below, the absence of such alternative

embodiments cannot be read into or inferred as inherent by one who reads Applicants' patent application. To do so is hindsight reconstruction, a forbidden practice. The Examiner cannot "read out" elements from the references in order to reject Applicants' claims. The references themselves must lead directly to these claims.

The Moronaga et al. '598 patent is directed to an insole for use in athletic shoes having an upper layer, a lower layer laminated on the upper layer, and a shock absorptive formed material layer laminated on the underside of the lower layer at least at the heel portion. Moronaga et al. '598, column 1, line 65, column 2, line 2.

In combining the references of the Masuda '738 patent and the Moronaga et al. '598 patent, a person of ordinary skill in the art would come up with a Masuda-like magnetic insole having the cushioning characteristics of the Moronaga et al. '598 patent. There is no indication in either patent as to the geometry or structure of such a resulting insole. The person of ordinary skill in the art can combine the two as they are without modification and without reference to Applicants' patent application. In so doing, it would be more natural and normal for a person of ordinary skill in the art to achieve a Moronaga et al.-type insole for a shoe having an additional magnetic core along the lines of Masuda.

Such an insole would not be the streamlined and efficiently compact one set forth in Applicants' application, but would be one that would be suffering from several different laminated layers that may cause an increased height thereby limiting the foot space available for the wearer. Additionally, such a synthesized laminated insole (arising from a combination of Masuda with Moronaga et al.) would depart from the use of large and small projections 3a, 3b, 4a, 4b present in the Masuda '738 reference. Consequently, combining the Moronaga et al. '598 reference with the Masuda '738 reference might result in an insole that not only does

not indicate or teach Applicants' claims, but destroys, alters, and/or teaches away from the insole present in the Masuda '738 patent.

Applicants' insole does not require or claim the flexible reinforcing material present and required in the Masuda reference. Nor does Applicants' method. The advantages to eliminating required parts, elements, and (for methods) steps enable Applicants' insoles to achieve more where before only less was available. By providing a better insole, Applicants' enable better and more comfortable magnetotherapy to be delivered to users' feet.

Applicants' tripartite laminated sheet enables a thinner insole that is easier to make than ones that would be achieved by combining Masuda and Moronaga et al.

The additional presence of the Baermann '532 and Bloom, Jr. '544 patent references do nothing to resolve the shortcomings of the Masuda and Moronaga patent references.

As a result, Applicants' believe that the claims as originally submitted and as amended by new claims 17 and 18 are patentable over the cited references taken in any reasonable combination, including Masuda and Moronaga et al.

The Patent Office has specific restrictions over how the examining corps and its Examiners may combine references in order to reject an Applicants' claim. These are set forth in § 2143.09 of the MPEP and are entitled Suggestion or Motivation to Modify References. According to Patent Office rules, the prior art must suggest a desirability of the claimed invention and must not just disclose the individual elements set forth in Applicants' claims.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed

invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In In re Kotzab, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference

disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one system may be used to control a number of valves. The court found that there was insufficient evidence to show that one system was the same as one sensor. While the control of multiple valves by a single sensor rather than by multiple sensors was a “technologically simple concept,” there was no finding “as to the specific understanding or principle within the knowledge of the skilled artisan” that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

In In re Fine, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

In In re Jones, the claimed invention was the 2-(2 ζ -aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed inter alia the substituted ammonium salts of dicamba as herbicides, however the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention.

Just like In re Kotzab, In re Fine, and In re Jones, Applicants' claims set forth a new system that uses elements that may have been previously known in the art. However, there is no motivation or indication to provide Applicants' specifically claimed configuration even though it may be a "technologically simple concept" as was the case in In re Kotzab. Consequently, Applicants' claims are allowable over the cited references even under the Patent Office's own rules and regulations.

The Patent Office has also set forth that the fact that references can be combined or modified is not sufficient to establish prima face obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The same is similarly true in the present situation. While the prior art references teach certain aspects of insoles and even magnetic insoles, there is no suggestion or motivation to

combine such references in order to achieve what is claimed by Applicants. Instead, by combining the Masuda and Moronaga et al. references, an entirely different insole is achieved. Not all insoles are alike and the development of insole technology is of particular importance not only to those with foot ailments, aches, and distress but also to athletes and those who rely upon their feet for performance, employment, or the like.

The Patent Office has also set forth specifically that the fact that a claimed invention is within the capabilities of one of ordinary skill in the art, this is not sufficient by itself to establish prima facie obviousness.

A statement that modifications of the prior art to meet the claimed invention would have been “`well within the ordinary skill of the art at the time the claimed invention was made’ “ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

Just as in these cases, the Examiner has used the knowledge of one of ordinary skill in the art at the time the invention was made to substitute for motivation, suggestion, or some indication in a publication that would lead a person of ordinary skill in the art to Applicants’

claimed invention. The Al-Site case prevents any reliance upon the level of skill in the art to provide the suggestion to combine the references while the Levengood and Kotzab cases require specific findings of either the specific principle or the specific understanding of the person of ordinary skill in the art that would have motivated the obtainment of Applicants' claimed invention.

The Court of Appeals for the Federal Circuit has made clear that hindsight reconstruction cannot be used to reject a claim and that the Examiner must show the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In reversing both the Board and the Examiner in their rejection of the claims, the Dembiczak Court made clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district

court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also Graham, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In the Dembiczak case, above, the Board fell into the hindsight trap.

The Dembiczak court noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re

Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) (“The examiner’s conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection.”). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. In Dembiczak, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

As in the examination proceedings in Dembiczak, the Examiner has fallen into the insidious trap of hindsight reconstruction and has found no motivation or teaching for combining the references.

No indication or teaching is present in either Masuda or Moronaga et al. that reveals the advantages of Applicants’ insole or its method of manufacture. Masuda makes no reference to an upper of any material and Moronaga et al. is silent on magnets and magnetotherapy. Consequently, only with hindsight in light of Applicants’ disclosure is a teaching to combine the two found. Only with hindsight is the advantage of Applicants’ insole seen.

Additionally, the Examiner has found no actual evidence by which the claims in Applicants’ patent application are achieved by combining the references. The clear and particular showing is not present and its absence undermines the Examiner’s broad conclusory statements regarding the teachings in Masuda, Moronaga et al., Baermann, and Bloom Jr.

From the foregoing, it can be seen that Applicants believe that there are a plurality of grounds upon which the rejections to the claims would be and are overcome. Applicants also believe that, for additional reasons, there is no teaching or motivation to combine the Masuda '738 reference with the Moronaga et al. '598 reference. In the recent past, the Court of Appeals for the Federal Circuit has spoken on this matter.

The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the present case, there is no disclosure or suggestion in any of the references relied on by the Examiner from which the insole and method therefore claimed by Applicants may be constructed. Indeed, even in light of Applicants' own teaching, the Examiner has been unable to reconstruct from the cited references such a method for such an insole which meets the language of the present claim.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and

(2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that as the relationships between the different elements are only found in Applicants' claims and nowhere else.

Applicants submit the Examiner has failed to demonstrate that the answer to either question should be decided against Applicants. None of the references, alone or in combination, disclose or suggest the combination of elements recited in Applicants' present claims. As such, Applicants' claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. A reading of each of the references uncovers no suggestion or teaching of any of them as to the advantages to be gained by having the compact and efficient insole set forth in Applicants' claims. Only the individual elements present in Applicants' claims have been found in the references and even so, not in the fashion that would make obvious Applicants' claims. No indication in either reference is given that the operating efficiencies of each would be maintained in the combination of a magnetic insole with a cushioning ability that is also perforated in order to allow airflow. The Examiner has

unsuccessfully tried to pull from the cited references specific elements claimed by Applicant (specifically Applicants' specific relationship, geometry, and characteristics set forth in Applicants' claims) based on Applicants' own teaching and not on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entireties, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. § 103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the references made of record and the references relied upon by the Examiner in the rejections. The claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). What the Examiner is attempting is a piecemeal construction of the prior art in view of the Applicants' own disclosure in order to negate the present invention. The law clearly does not give sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art "

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in either the Masuda or the Moronaga et al. references relied on by the Examiner from which the invention claimed by Applicants can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination. . . . It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

From the foregoing remarks, Applicants' claims, including new claims 17 and 18, are believed to be patentable over the Masuda '738 reference in light of the Moronaga et al. '598 reference. The addition of the Baermann '532 reference and the Bloom Jr. '544 reference do nothing to remedy the shortcomings of the Masuda and Moronaga et al. references.

In view of the above, the Examiner is respectfully requested to reconsider his position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicants invite the Examiner to contact Applicants' representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicants respectfully request the Examiner to pass the application on to allowance. It is not believed that any additional fees are due; however, in the event any

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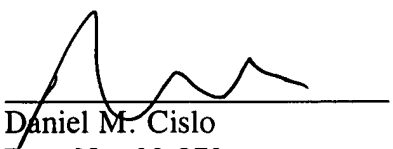
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additional fees are due, the Examiner is authorized to charge Applicants' Attorney's Deposit
Account No. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Date: December ²⁴ 2003



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Enclosure

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